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PATENT  
Attorney Docket No. 016354.0204

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

John BARANOWSKI

Examiner: Kenneth W. NOLAND

Application Number: 10/601,670

Group Art Unit: 3561

Filed: June 24, 2003

Confirmation No.: 8445

For: DISPENSING AND DIVERSION  
SYSTEMS AND METHODS

RESPONSE TO ELECTION OF GROUP REQUIREMENT

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

In an Office Action mailed March 4, 2005, the Office Action identified the following allegedly, patentably distinct groups and requested that Applicant elect one of these groups for prosecution in the above-captioned patent application:

<u>Group</u>	<u>Claims</u>	<u>Description</u>
<b>Group I</b> (claims 1-20)		Drawn to a dispensing apparatus or system classified in Class 221, Subclass 92.
<b>Group II</b> (claims 21-30)		Drawn to a method of dispensing classified in Class 221, Subclass 1.

**In response to that Office Action, Applicant respectfully elects Group I (claims 1-20), with traverse.**

Remarks:

According to the MPEP, a restriction between inventions is appropriate only when the inventions are shown to be distinct and when there would be a "serious burden" placed on the examiner to examine more than one invention in the same application. "If the search and

examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP 803 (emphasis added).

MPEP 803 provides that "[e]xaminers must provide reasons and/or examples to support conclusions . . . ." (Emphasis added.) The Office Action has not given sufficient reasons and/or examples in support of the imposition of this restriction requirement. According to MPEP 806.05(e), "[p]rocess and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process." (Italics in original and underlining added.) The Office Action contends that "the process as claimed [in claims 21-30] can be practiced by another materially different apparatus, or by hand." Office Action, Page 2, Lines 7-8. Nevertheless, Applicant maintains that the Office Action has failed to describe a "materially different apparatus" or a "materially different process." Without such a description of an allegedly, materially different apparatus or process, the Office Action fails to provide adequate "reasons and/or examples to support [its] conclusions." MPEP 803. Moreover, the Office Action fails to demonstrate that "the process *as claimed*" could be accomplished "by hand." At most, the Office Action suggests that a step or steps included in the process might possibly be done "by hand," but Applicant maintains that this fails to demonstrate that "the process *as claimed*" could be done "by hand" or that the steps which the Office Action suggests might be done "by hand" could be combined with steps done by an apparatus to accomplish "the process *as claimed*." Office Action, Page 2, Lines 10-12.

In addition, the Office Action contends that "these inventions . . . have acquired separate status in the art as shown by their different classification." Office Action, Page 2, Lines 13-15. This contention is unsupported by the facts. The Office Action itself notes that both the apparatus and process claims fall within the same class, namely, Class 221. According to the MPEP, when two allegedly separate inventions fall into the same class, the only way to show separate status in the art is "by citing patents which are evidence of such separate status." MPEP 808.02(B). The Office Action fails to cite any such patents and, therefore, fails to support the restriction requirement on the basis of classification alone. To the extent the Office Action relies on the differences in subclasses between the two allegedly separate inventions, Applicant

maintains that distinction alone is insufficient to support this restriction. Moreover, it would not impose a serious burden on the Examiner to search two subclasses. Typically, examiners search more than one subclass in performing their searches for prior art for a single invention. The Office Action fails to demonstrate why searching both subclasses 92 and 1 in this application now would be impose a serious burden on the Examiner. Accordingly, Applicant respectfully requests that the Examiner withdraw the restriction requirement.

**Conclusion:**

Applicant respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicant's representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity.

Respectfully submitted,  
BAKER BOTTS L.L.P.

Dated: March 31, 2005

By: 

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